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09/622,257	01/02/2000	Pierre Coutos-Thevenot	0061/00091	8211

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EXAMINER

KALLIS, RUSSELL

ART UNIT

PAPER NUMBER

1638

21

DATE MAILED: 06/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/622,257

Applicant(s)

COUTOS-THEVENOT ET AL.

Examiner

Russell Kallis

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30 and 31 is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-29, 32 and 33 is/are rejected.
- 7) ☒ Claim(s) 2-3, 7-8, 13-19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 19.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The Office acknowledges receipt of Applicants Response; dated March 20, 2003, paper number 20.
2. Applicant has cancelled claim 10 and amended claims 1-9 and 11-29 and new Claims 30-33 have been added. Claims 1-9 and 11-33 are pending, and are examined in the instant action.
3. This action is made FINAL necessitated by Applicant's amendment.
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1-29 rejected under 35 U.S.C. 112, second paragraph are withdrawn in view of Applicant's amendments.

### ***Claim Objections***

6. Claims 2-3, 7-8, and 13-19 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 2 fails to further limit Claim 1. Presumably the promoter of Claim 1 is inducible.

Claim 3 fails to further limit Claim 1 because it is broader in scope than Claim 1. Claim 3 recites fragments of SEQ ID NO: 3.

Claim 7 fails to further limit Claim 1. Presumably SEQ ID NO: 3 already encodes the grapevine stilbene synthase.

Claim 8 fails to further limit Claim 7. Claim 8 is broader in scope than Claim 7.

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Claim 13-19 fail to further limit Claim 9 and independent Claim 1. Presumably the promoter of Claim 1 is inducible.

***Claim Rejections - 35 USC § 112***

7. Claims 3-6 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is maintained for the reasons of record set forth in the Official actions mailed 7/03/02. Applicants arguments filed 3/20/03 have been considered but are not deemed persuasive.

Applicant asserts that the screening for promoters having at least 80%, 90%, or 95% sequence identity to SEQ ID NO: 3 and still function, presumably in an inducible fashion, and fragments of SEQ ID NO: 3 that would remain functional, presumably in an inducible fashion, in a plant could be performed by undergraduate students and are therefore routine in nature (response page 2). Applicant describes only the single promoter sequence of SEQ ID NO: 1 and the single stilbene synthase coding DNA of SEQ ID NO: 2, which together constitute SEQ ID NO: 3. Applicant does not provide written description for other promoter or coding sequences, encompassed by the claimed genus. In particular, Applicant does not describe sequence with 80% identity to SEQ ID NO: 3 or fragments of SEQ ID NO: 3 that function in the claimed invention. Applicant's arguments with respect to screening said sequences is inappropriate to counter a written description rejection.

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8. Claims 3-6 and 23-27 remain rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a nucleic acid sequence of SEQ ID NO: 3 comprising the lucerne PR1 promoter of SEQ ID NO: 1 and the stilbene synthase coding sequence of SEQ ID NO: 2., and the transformation of grapevine therewith, does not reasonably provide enablement for the composition and structure of other polynucleotides comprising other Lucerne PR promoters and other stilbene synthase coding sequences. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. This rejection is maintained for the reasons of record set forth in the Official actions mailed 7/03/02. Applicants arguments filed 3/20/03 have been considered but are not deemed persuasive. Applicant does not respond to this rejection in the response filed 3/20/03, and therefore the rejection is maintained.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-9, 11-29, and 32-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. All dependent claims are included in the rejection.

At Claim 1, line 3, "conprises" should be --comprises--.

At Claim 1, line 4, "SEQ. ID. NO.:3" should be --SEQ ID NO : 3--.

At Claims 2-3, line 1, "claim 1" should be --Claim 1--.

At Claim 3, line 5 and throughout the claims, "said SEQ. ID. NO.: 3 sequence" should be --SEQ ID NO: 3--.

At Claim 20, line 1, "Plant cells" should be --A plant cell--.

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At Claims 22 and 29, line 2, method steps must be in gerund verb form i.e. transforming (see suggested change to Claim 23 below).

Claim 23, the entire claim should be changed to read in the following format,

--A method for making a plant that expresses a stilbene synthase comprising:

- a) transforming a plant cell with the plant expression vector of Claim 9; and
- b) regenerating a transformed plant from said cell, wherein said plant expresses a stilbene synthase.--

Claim 1 recites the limitation "the sequence" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the promoter" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the gene" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the sequence" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claims 1-9 and 11-33 are deemed free of the prior art, given the failure of the prior art to teach or reasonably suggest a plant expression vector of SEQ ID NO: 3 and plant cells and plants transformed therewith.

Claims 1-9, 11-29, and 32-33 are rejected.

Claims 30-31 are allowed.

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Kallis whose telephone number is (703) 305-5417. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Russell Kallis Ph.D.  
June 2, 2003

A handwritten signature in black ink, appearing to read "Amy Nelson", with a stylized, cursive script.

**AMY J. NELSON, PH.D**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**